

REMARKS

SUMMARY:

The Office Action objects to claims 28-39 for typographical errors related to the dependency relationships of among the claims. In response, Applicants have amended the claims to correct the dependency relationships.

Claims 1-26 stand rejected under 35 U.S.C § 101 on grounds that the claimed invention is directed to non-statutory subject matter. The Office Action, however, has not established a prima facie case for rejecting claims 1-26 under 35 U.S.C § 101. Furthermore, Applicants' demonstrated that the claims are limited to a practical application within the technological arts in satisfaction of 35 U.S.C § 101.

Claims 1-39 stand rejected for obviousness under 35 U.S.C § 103(a) as being unpatentable over Bryan in view of Capra. Claims of the present application claim methods, systems, and products for differential dynamic content delivery that includes providing a session document for a presentation, wherein the session document includes a session grammar and a session structured document. The Office Action attempts to equate Bryan's voice portals, Capra's models of content, and Capra's grammar with a session document as claimed in the present application. A session document, however, contains filtered presentation content that is filtered according to attributes of an audience for a presentation. Bryan's voice portals, Capra's models, and Capra's grammar have nothing whatsoever to do with filtered presentation content according to attributes of an audience for a presentation.

DETAILED ANALYSIS:

CLAIM OBJECTIONS

The Office Action on page 2 objects to claims 28-39 stating:

Claims 28-39 are objected to because of the following informalities:
Claims 28-39 recite a computer program product and it appears that they should depend from independent claim 27 and the subsequent dependent claims. However it appears that these claims contain numerous typographical errors, since they are written to depend from the system claims of independent claim 14 and its dependent claims.

That is, the Office Action objects to claims 28-39 because of typographical errors relating to the dependencies of claims 28-39. Applicants have amended claim 28-39 as follows:

- Claims 28, 29, and 31-34 now depend from claim 27,
- Claim 30 now depends from claim 29,
- Claims 35 and 37 now depend from claim 34,
- Claim 36 now depends from claim 35, and
- Claims 38 and 39 now depends from claim 37.

Applicants have added no new matter. The objections of claims 28-39 therefore should be withdrawn, and the claims be allowed.

CLAIM REJECTIONS – 35 U.S.C. § 101

Claims 1-26 stand rejected under 35 U.S.C § 101 on grounds that the claimed invention is directed to non-statutory subject matter. The Office Action at page 3 states:

Claim 1-26 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

In regard to independent claims 1 and 14, claims 1 and 14 are nonstatutory because they claim nonfunctional descriptive material and represent abstract ideas (*Interim Guidelines for Examination of Patent Applications*

for Patent Subject Matter Eligibility; hereinafter “Interim Guidelines”, P. 50-51). Note that merely claiming nonfunctional descriptive material, i.e., abstract ideas, stored in a computer-readable medium, does not make it statutory since the requisite functionality to satisfy the practical application requirement must also be present (Interim Guidelines, p. 51).

...

As claimed, claim 1 claims a collection of abstract ideas not recorded on a computer-readable medium, and thereby claims nonfunctional descriptive material. Similarly, while claim 11 claims a system, the system as claimed also represents a collection of abstract ideas which are not recorded on a computer readable medium.

Applicants respectfully note in response that a claimed invention constitutes patentable subject matter under 35 U.S.C. § 101 if the claimed invention as a whole produces a “useful, concrete and tangible result.” *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 149 F. 3d 1368, 1373, 47 USPQ2d 1596, 1601-02 (Fed. Cir. 1998). In rejecting claim 1 under 35 U.S.C. § 101, “[o]ffice personnel have the burden to establish a prima facie case that the claimed invention as a whole is directed to solely an abstract idea or to manipulation of abstract ideas or does not produce a useful result. Only when the claim is devoid of any limitation to a practical application in the technological arts should it be rejected under 35 U.S.C. 101.” *Manual of Patent Examining Procedure* § 2106 II A. In this case, the Office Action does not offer any explanation as to why Applicants’ claims 1-26 are directed to solely an abstract idea, the manipulation of abstract ideas, or as to why Applicants’ claims 1-26 do not produce a useful result. The Office Action therefore does not establish a prima facie case of non-statutory subject matter under 35 U.S.C. § 101, and the rejections should be withdrawn.

In addition, when the Office Action rejects a claim under 35 U.S.C. § 101, “Office personnel must expressly state how the language of the claims has been interpreted to support the rejection.” *Manual of Patent Examining Procedure* § 2106 II A. In this case, the Office Action states nothing to indicate “how the language of the claims has

been interpreted to support the rejection.” Because the Office Action does not provide any statement of explanation as to how claims 1-26 have been interpreted to support the rejection under 35 U.S.C. § 101, the Office Action does not comply with *Manual of Patent Examining Procedure* § 2106 II A. The Office Action therefore does not establish a prima facie case of non-statutory subject matter under 35 U.S.C. § 101, and the rejections should be withdrawn.

In the absence of a prima facie showing of unpatentable subject matter under 35 U.S.C. § 101, Applicants are under no obligation to respond further on this issue. Nevertheless, in an effort to move the case forward, Applicants demonstrate that the present claims clearly claim a statutory process limited to a practical application within the technological arts. According to 35 U.S.C. § 100(b), a ‘method’ is a process patentable under 35 U.S.C. § 101. In determining whether a process satisfies the requirements of 35 U.S.C. § 101, MPEP § 2106IVB2(b) states, “To be statutory, a claimed computer-related process must...be limited to a practical application within the technological arts.” Applicants’ clearly claim a computer-related process as demonstrated by the paragraph beginning at page 8, line 5, in the original application that states:

The present invention is described to a large extent in this specification in terms of methods for differential dynamic content delivery. Persons skilled in the art, however, will recognize that any computer system that includes suitable programming means for operating in accordance with the disclosed methods also falls well within the scope of the present invention. Suitable programming means include any means for directing a computer system to execute the steps of the method of the invention, including for example, systems comprised of processing units and arithmetic-logic circuits coupled to computer memory, which systems have the capability of storing in computer memory, which computer memory includes electronic circuits configured to store data and program instructions, programmed steps of the method of the invention for execution by a processing unit.

Turning now to whether the Applicants claims are limited to a practical application, MPEP § 2106IVB2(b)(ii) states, in part, “A claim is limited to a practical application

when the method, as claimed, produces a concrete, tangible, and useful result....” It is well established by, for example, *In re Alappat*, 33 F.3d 1526, 31 USPQ2d 1545 (Fed. Cir. 1994)(in banc), and *State Street Bank & Trust Co. v. Signature Financial Group*, 149 F.3d 1368 (Fed. Cir. 1998), that claims to transformations of data by a machine through a series of calculations are claims to statutory subject matter within the meaning of 35 U.S.C. § 101 because a concrete, tangible, and useful result is produced. The Court in *State Street Bank* stated:

Today, we hold that the transformation of data, representing discrete dollar amounts, by a machine through a series of mathematical calculations into a final share price, constitutes a practical application of a mathematical algorithm, formula, or calculation, because it produces "a useful, concrete and tangible result" -- a final share price momentarily fixed for recording and reporting purposes and even accepted and relied upon by regulatory authorities and in subsequent trades.

Claims 1-26 of the present application claim differential dynamic content delivery that include:

- providing a session document for a presentation, wherein the session document includes a session grammar and a session structured document;
- receiving a prerecorded presentation control instruction;
- selecting from the session structured document a classified structural element in dependence upon the prerecorded presentation control instruction and in dependence upon user classifications of a user participant in the presentation; and
- presenting the selected structural element to the user.

Claims directed to differential dynamic content delivery are clearly claims directed to a transformation of data within the meaning of *Alapat* and *State Street Bank* because 'presenting the selected structural element to the user' produces a useful, concrete, and tangible result. In fact, Applicants' extensive specification sets forth over 70 pages clearly describing the concrete, tangible, and useful result of Applicants' methods for differential dynamic content delivery as claimed in claims 1-26. Because claims 1-26 produce a concrete, tangible, and useful result, claims 1-26 are patentable subject matter under 35 U.S.C. § 101. Applicants respectfully traverse each rejection individually below and request reconsideration of claims 1-26.

CLAIM REJECTIONS – 35 U.S.C. § 103 OVER BRYAN IN VIEW OF CAPRA

Claims 1-39 stand rejected for obviousness under 35 U.S.C § 103(a) as being unpatentable over Bryan, *et al.* (U.S. Patent No. 6,658,414 B2) in view of Capra, *et al.*, *WebContext: Remote Access to Shared Context*, ACM International Conference Proceeding Series, Vol. 15, Proceedings of the 2001 Workshop on Perceptive User Interfaces, 2001, pgs. 1-9. To establish a prima facie case of obviousness, three basic criteria must be met. *Manual of Patent Examining Procedure* §2142. The first element of a prima facie case of obviousness under 35 U.S.C. § 103 is that the proposed combination of Bryan and Capra must teach or suggest all of Applicants' claim limitations. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974). The second element of a prima facie case of obviousness under 35 U.S.C. § 103 is that there must be a suggestion or motivation to combine Bryan and Capra. *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). The third element of a prima facie case of obviousness under 35 U.S.C. § 103 is that there must be a reasonable expectation of success in the proposed combination of Bryan and Capra. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986). As demonstrated below, the combination of Bryan and Capra does not establish a prima facie case of obviousness. The rejection of claims 1-39 should therefore be withdrawn and the case should be

allowed. Applicants respectfully traverse each rejection individually and request reconsideration of claims 1-39.

The Proposed Combination Of Bryan And Capra Does Not Teach
Or Suggest All Of Applicants' Claim Limitations

To establish a prima facie case of obviousness, the proposed combination of Bryan and Capra must disclose all of the Applicants' claim limitations. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974). Independent claim 1 of the present application claims:

1. (Original) A method for differential dynamic content delivery, the method comprising:

providing a session document for a presentation, wherein the session document includes a session grammar and a session structured document;

receiving a prerecorded presentation control instruction;

selecting from the session structured document a classified structural element in dependence upon the prerecorded presentation control instruction and in dependence upon user classifications of a user participant in the presentation; and

presenting the selected structural element to the user.

Bryan And Capra Do Not Teach Or Suggest Providing A Session Document
For A Presentation, Wherein The Session Document Includes
A Session Grammar And A Session Structured Document

The first element of claim 1 claims "providing a session document for a presentation, wherein the session document includes a session grammar and a session structured

document....” Regarding the first element of claim 1, the Office Action at pages 4 and 5 states:

A method for differential dynamic content delivery, the method comprising: providing a session document for a presentation, wherein the session document includes a session grammar and a session structured document; Bryan teaches a voice portal for dynamic content delivery with a session database which maintains the session context and information for the user (Col. 9, l. 9-14). While Bryan does not explicitly teach providing a session document, i.e., a structured document, Capra teaches a method for differential content delivery, enabling remotely accessible shared context (p. 1, 2, Sect. 3), with a context grammar including session information and grammar, i.e., specifying the time frame in which web pages were browsed (p. 6, Sect. 5.2.3, especially, p.6 Col. 2, par. 7), contained in an XML document (p. 5-6, Sect. 5.2.2). Therefore, Capra teaches recording session information and a session grammar in a structured document.

That is, the Office Action takes the position that Bryan at column 9, lines 9-14 and Capra at pages 1 and 2 (which includes section 3), section 5.2.2, and section 5.2.3 teaches or suggests the first element of claim 1. Applicants respectfully note in response that what Bryan at column 9, lines 9-14 in fact discloses is:

When a user accesses his or her voice portal, session database 106 maintains a context for the user. For example, session database 106 may store state information indicating where the user is in a particular voice portal in order to allow the user to return to that location should the user so desire.

The modules and databases illustrated in FIG. 1 may execute on any suitable hardware platform. In a preferred embodiment, the hardware platform comprises one or more enterprise servers 118. Enterprise servers suitable for use with embodiments of the present invention include the Enterprise 220 or 440 servers available from SUN Microsystems and the RISC 6000 available from IBM Corporation.

That is, Bryan at column 9, lines 9-14, discloses a session database that maintains a context for a user and locations in the voice portal accessed by a user. Bryan’s session database that maintains a context for a user and locations in the voice portal accessed by a

user is not providing a session document for a presentation, wherein the session document includes a session grammar and a session structured document. The original application at the paragraph beginning at page 31, line 10, describes a session document stating:

A session document is a repository for filtered content, presentation content that is filtered according to attributes of an audience for a presentation, an audience that presents a range of affiliations, technical abilities, security authorizations, and other attributes as will occur to those of skill in the art. The purpose of a session document is to provide a repository for reducing the volume of data for a presentation with respect to unfiltered presentation documents. A session document is a document derived from a presentation document targeted for the participants of a presentation. More particularly, a session document is a data structure that includes a session grammar derived from a presentation grammar in a presentation document and a session structured document derived from a structured document in a presentation document. Further, it was notoriously well known in the art at the time of the invention that session information could be recorded in both structured documents and database entries.

That is, a session document is a document derived from a presentation document targeted for the participants of a presentation that includes a session grammar derived from a presentation grammar in a presentation document and a session structured document derived from a structured document in a presentation document. Bryan at column 9, lines 9-14, has nothing whatsoever to do with a session document as claimed in the application because Bryan's session database is clearly not a session document. Bryan's session database does not contain filtered presentation content according to attributes of an audience for a presentation. In fact, Bryan at column 9, lines 9-14, does not even mention 'session document,' 'session document for a presentation,' 'session grammar,' 'a session structured document,' or 'providing a session document for a presentation, wherein the session document includes a session grammar and a session structured document.' Because the combination of Bryan and Capra does not teach or suggest each and every element and limitation of Applicants' claims, combination of Bryan and Capra

does not establish a prima facie case of obviousness, and the rejections should be withdrawn.

Turning now to Capra at pages 1 and 2, Applicants respectfully note in response that what Capra at pages 1 and 2 in fact discloses is a system that allows a user to browse web pages on a computer and then remotely make queries about the information seen on the web pages using a telephone-based voice user interface. Capra's system that allows a user to browse web pages on a computer and then remotely make queries about the information seen on the web pages using a telephone-based voice user interface is not providing a session document for a presentation, wherein the session document includes a session grammar and a session structured document. As mentioned above, a session document is a document derived from a presentation document targeted for the participants of a presentation that includes a session grammar derived from a presentation grammar in a presentation document and a session structured document derived from a structured document in a presentation document. Capra at pages 1 and 2 has nothing whatsoever to do with a session document as claimed in the application. In fact, Capra at pages 1 and 2 does not even mention 'session document,' 'session document for a presentation,' 'session grammar,' 'a session structured document,' or 'providing a session document for a presentation, wherein the session document includes a session grammar and a session structured document.' Because the combination of Bryan and Capra does not teach or suggest each and every element and limitation of Applicants' claims, combination of Bryan and Capra does not establish a prima facie case of obviousness, and the rejections should be withdrawn.

Turning now to section 5.2.2 of Capra, Applicants respectfully note in response that what Capra at section 5.2.2 in fact discloses is:

Building Context Models (2)

The second part of the WebContext architecture is focused on building models of context based on the archived web pages that the user browsed (i.e. the pages collected by the proxy server).

Currently, we model context by extracting information out of the archived HTML pages. An extractor program (written in Perl) with modules for extracting various information pieces is run on each HTML page in the set of archived pages. For each page, the extractor produces a counterpart XML document that represents context indicators and information pieces found on that page. The XML document is stored in a simple XML-based specification language we have been developing to help represent context. For convenience in this paper, we will refer to this as the Shared Context Representation Markup Language (SCRML). This representation is in the early development stages and is still evolving.

The extractor program looks for two major types of data in the HTML pages: extractable information pieces and context indicators. Information pieces are things like phone numbers, addresses, and dates that the extractor has a module to identify and extract. Context indicators are items on the page that help identify it and related pages. The title of the page, words that appear in links or in bold type, and headings can all be used as context indicators. The body text of the page is also treated as a context indicator and is used in later processing stages to help build a language model to allow the user to speak about words and phrases they saw on the page.

The SCRML page contains information pieces found by the extractor modules, context indicators found by the extractor main program, and additional information that can be determined about the page or that has been provided by the proxy server or browser. Figure 4 shows an example of the SCRML generated from the Anytown Hotel web page example (Figure 1).

That is, Capra at section 5.2.2 discloses building models of context based on the archived web pages that a user browsed. Capra's models of context based on the archived web pages that a user browsed is not providing a session document for a presentation, wherein

the session document includes a session grammar and a session structured document as claimed in the present application. As explained above, a session document is a document derived from a presentation document targeted for the participants of a presentation that includes a session grammar derived from a presentation grammar in a presentation document and a session structured document derived from a structured document in a presentation document. Capra's models of content are not session documents because Capra's models have nothing to do with a session grammar and a session structured document. Capra's models do not contain filtered presentation content according to attributes of an audience for a presentation. In fact, Capra at section 5.2.2 does not even mention 'session document,' 'session document for a presentation,' 'session grammar,' 'a session structured document,' or 'providing a session document for a presentation, wherein the session document includes a session grammar and a session structured document.' Because the combination of Bryan and Capra does not teach or suggest each and every element and limitation of Applicants' claims, combination of Bryan and Capra does not establish a prima facie case of obviousness, and the rejections should be withdrawn.

Turning now to section 5.2.3 of Capra, Applicants respectfully note in response that what Capra at section 5.2.3 in fact discloses is creating a grammar for use by voice applications from the information stored in the document models mentioned above. Capra's grammar for use by voice applications is not providing a session document for a presentation, wherein the session document includes a session grammar and a session structured document as claimed in the present application. As explained above, a session document is a data structure that includes a session grammar derived from a presentation grammar in a presentation document and a session structured document derived from a structured document in a presentation document. Capra's grammar is neither a session document nor a session grammar of a session document because Capra's grammar is not derived from presentation grammar. In fact, Capra at section 5.2.3 does not even mention 'session document,' 'session document for a presentation,' 'session grammar,' 'a session structured document,' or 'providing a session document for a presentation, wherein the

session document includes a session grammar and a session structured document.’
Because the combination of Bryan and Capra does not teach or suggest each and every element and limitation of Applicants’ claims, combination of Bryan and Capra does not establish a prima facie case of obviousness, and the rejections should be withdrawn.

Bryan Does Not Teach Or Suggest Receiving A Prerecorded Presentation Control Instruction; Selecting From The Session Structured Document A Classified Structural Element In Dependence Upon The Prerecorded Presentation Control Instruction And In Dependence Upon User Classifications Of A User Participant In The Presentation; And Presenting The Selected Structural Element To The User

The second, third, and fourth elements of claim 1 claims “receiving a prerecorded presentation control instruction; selecting from the session structured document a classified structural element in dependence upon the prerecorded presentation control instruction and in dependence upon user classifications of a user participant in the presentation; and presenting the selected structural element to the user.” Regarding the second element of claim 1, the Office Action at pages 5 and 6 states:

Claim 1 also cites: receiving a prerecorded presentation control instruction; selecting from the session structured document a classified structural element in dependence upon the prerecorded presentation control instruction and in dependence upon user classifications of a user participant in the presentation; and presenting the selected structural element to the user.

Bryan teaches that a user may create a unique, personalized voice portal with keywords, and audio macros, i.e., prerecorded presentation control instructions, which are linked with user classifications, such as data sources of interest, as well as the user identification (Col. 9, l. 22-60). The user uses the prerecorded keywords or macros to access and be presented with presentation elements, such as a stock quote or user specified information (Col. 11, l. 6-54).

That is, the Office Action takes the position that Bryan at column 9, lines 22-60 and column 11, lines 6-54 discloses the second, third, and fourth elements of claim 1.

Applicants respectfully note in response, however, that what Bryan at column 9, lines 22-60, in fact discloses is:

FIG. 2 is a flow chart illustrating the overall process flow of the methods and systems for generating and providing access to user-definable voice portals according to an embodiment of the present invention. In FIG. 2, in step ST1, when a user desires to create a voice portal, the user accesses topic radio tuner user interface 100 and topic radio engine 104 assigns the user a unique identifier. This identifier is important because it identifies the user and associates the user with a voice portal. The identifier may be any suitable identifier for uniquely identifying the user. For example, the identifier may be a number or combination of characters selected by the user or generated by the system. In an alternative embodiment, the systems for generating and providing user access to voice portals may use biometric identification methods, such as a voice signature, a fingerprint, retinal scan, or any other suitable identifier for uniquely identifying the user.

Once an identifier has been assigned to the user, in step ST2, topic radio engine 104 extracts, based on the identifier, a template from template database 108 which prompts the user for data sources, keywords for searching the data sources, time intervals of interest for the searches, and vocabulary words or grammar associated with the information. This step allows the user to select not only the data sources that are of interest to the user, but also a word or phrase (the audio macro) that is easy for the user to remember in order to access the data sources. For example, a cardiologist may choose "heart" as the vocabulary word or audio macro to be spoken in order to access all articles in the last three months on the New England Journal of Medicine on angiogenesis. The user may associate different vocabulary words with different data sources. For example the user may select "portfolio" to access stock quotes for stocks in the user's stock portfolio. Because each user defines an individual voice portal, if there are one million or more users, the users can define the same audio macro "heart" and associate the audio macro with one million different data sources.

That is, Bryan at column 9, lines 22-60, discloses generating and providing access to user-definable voice portals using an audio macro. Bryan's generating and providing access to user-definable voice portals using an audio macro is not: receiving a prerecorded presentation control instruction; selecting from the session structured

document a classified structural element in dependence upon the prerecorded presentation control instruction and in dependence upon user classifications of a user participant in the presentation; and presenting the selected structural element to the user as claimed in the present application. Applicants describe presentation control instructions in the original application at the paragraphs beginning on page 9, line 21, stating:

In typical embodiments, presentation control instructions are represented by and formulated from presentation action identifiers (reference 518 on Figure 5). Key phrases are spoken by users and presented as speech input to voice response server (104) where they are parsed and used to select a presentation action identifier (518 on Figure 5) from a VRS grammar (105). VRS grammar (105) is formed dynamically from presentation grammars (120) in use in a presentation session (128). In some embodiments, VRS grammar (105) is formed dynamically from user grammars from user profiles (126). Presentation Session Control Language ("PSCL") stream (132) represents a stream of presentation control instructions composed of presentation action identifiers (518 on Figure 5) and optional presentation control parameters (520 on Figure 5) from VRS (104) to presentation server (102) which is programmed to present (134) structured multimedia content (136) from structured documents (122) to users (124) in accordance with such presentation control instructions (132).

Figure 2 includes a profile class (126) whose objects represent presentation users. The profile class (126) includes a user name (204), a password (206), and a reference to a user grammar (208). A user grammar is a data structure that includes a set of key phrases that are used to select presentation action identifiers specific to a user for use in formulating presentation control instructions. For a presentation control instruction that instructs a presentation session to carry out the presentation action 'page down,' for example, an individual user may chose to associate with that presentation control instruction the key phrase "rock and roll" or "boogie on down" or any other key phrase favored by a user as will occur to those of skill in the art. Although these particular examples are somewhat fanciful, in fact, user grammars serve a useful purpose by providing key phrases for presentation control instructions that distinguish normal speech. In a discussion of a word processing document, for example, references to pages and paragraphs may abound, and using a distinctive phrase to invoke presentation control instructions on pages and paragraphs reduces the risk of confusion on the part of a voice response server and a presentation session.

That is, presentation control instructions instruct a presentation session to carry out a presentation action such as, for example, 'page down.' Furthermore, Readers will note from the elements of claim 1 listed above that a classified structural element is included in a session structured document, which, in turn, is included in a session document. As explained above, a session document is a document derived from a presentation document targeted for the participants of a presentation that includes a session grammar derived from a presentation grammar in a presentation document and a session structured document derived from a structured document in a presentation document. A voice portal of Bryan is an audio interface that allows an end user to search and access information using primarily spoken commands. Bryan at column 1, lines 17-19. An audio macro of Bryan is a word a user assigns to access either a specific source or piece of information or multiple sources or pieces of information with due regard to the associated reference source, full-text search, and temporal information. Bryan at column 5, lines 47-51. Bryan's voice portals and audio macro, therefore, have nothing whatsoever to do with presentation control instructions, a session document, or classified structural elements as claimed in the present application. In fact, Bryan at column 9, lines 22-60, does not even mention 'classified structural element ,' 'session structured document,' 'presentation control instruction,' 'user classifications of a user participant in the presentation,' 'receiving a prerecorded presentation control instruction,' 'selecting from the session structured document a classified structural element in dependence upon the prerecorded presentation control instruction and in dependence upon user classifications of a user participant in the presentation,' and 'presenting the selected structural element to the user.' Because the combination of Bryan and Capra does not teach or suggest each and every element and limitation of Applicants' claims, combination of Bryan and Capra does not establish a prima facie case of obviousness, and the rejections should be withdrawn.

Turning now to Bryan at column 11, lines 6-54, Applicants respectfully note in response that what Bryan at column 11, lines 6-54 discloses is:

Referring back to FIG. 2, once a user has selected vocabulary words or audio macros, data sources, and time intervals, in step ST3, topic radio engine 104 stores this information in database 108 and provides the data source, keyword, and time information to data gathering engine 110, which searches the specified data sources using the specified keywords and stores the results in cache/database 114. Storing the user-specified audio macros, data sources, keywords, and temporal information in database 108 and pre-fetching the information requested by that user effectively creates a unique voice portal per user (step ST4). Searching the user-specified data sources may be performed continuously or periodically to decrease access time when the user seeks to access the information via the user's voice portal. In addition, because the searching only occurs in the user-specified data sources, the level of detail in a search can be increased. For example, a user may select IEEE Spectrum magazine as a data source. Because the search space is limited, the level of detail is increased. In this example, full text searching of the articles in IEEE Spectrum magazine could be accomplished without an undue burden on system resources because the search space is limited. Such full text searching is not feasible in conventional voice portals that utilize the entire Internet as the data source being searched when a user enters a request.

Once the search results have been cached or stored in a database, topic radio engine 104 is prepared to serve the information to the user. In step ST5, topic radio engine 104 provides access to the unique voice portal per user via a user interface device, such as a telephone (landline or mobile), a personal digital assistant (PDA), a personal computer, or any other form of user interface device. The user may utilize the vocabulary word or vocabulary words defined by that user to access the user's data sources. This greatly facilitates an individual's ability to access information. In addition, if a user desires to save information for later listening, the user may utter a predetermined keyword, such as "save", and the message may be saved in any suitable format for later access, such as a .WAV file or a text file, and sent to the user's email account or other location, such as the user's PDA, fax machine, etc., for later listening or access.

In step ST6, topic radio engine 104 allows the user to modify the voice portal to change the voice portal that has been previously generated for the user by repeating steps ST2-ST5. The steps illustrated in FIG. 2 may be repeated by each user in a multi-user system to generate unique per-user voice portals having user-specified data sources, search keywords, time periods, and grammar.

That is, Bryan at column 11, lines 6-54, discloses creating a voice portal for a user by storing user-specified audio macros, data sources, keywords, and temporal information in a database, and pre-fetching the information requested by the particular user. Bryan's creating a voice portal for a user is not: receiving a prerecorded presentation control instruction; selecting from the session structured document a classified structural element in dependence upon the prerecorded presentation control instruction and in dependence upon user classifications of a user participant in the presentation; and presenting the selected structural element to the user as claimed in the present application. As mentioned above, a presentation control instruction instructs a presentation session to carry out a presentation action such as, for example, 'page down.' Also from above, readers will note that a classified structural element is included in a session structured document, which, in turn, is included in a session document. A session document is a document derived from a presentation document targeted for the participants of a presentation that includes a session grammar derived from a presentation grammar in a presentation document and a session structured document derived from a structured document in a presentation document. As mentioned above, a voice portal of Bryan is an audio interface that allows an end user to search and access information using primarily spoken commands. Bryan at column 1, lines 17-19. An audio macro of Bryan is a word a user assigns to access either a specific source or piece of information or multiple sources or pieces of information with due regard to the associated reference source, full-text search, and temporal information. Bryan at column 5, lines 47-51. Bryan's voice portals and audio macro, therefore, have nothing whatsoever to do with a presentation control instruction, a session document, or classified structural elements as claimed in the present application. In fact, Bryan at column 11, lines 6-54, does not even mention 'classified structural element,' 'session structured document,' 'presentation control instruction,' 'user classifications of a user participant in the presentation,' 'receiving a prerecorded presentation control instruction,' 'selecting from the session structured document a classified structural element in dependence upon the prerecorded presentation control instruction and in dependence upon user classifications of a user participant in the presentation,' and 'presenting the selected structural element to the user.' Because the

combination of Bryan and Capra does not teach or suggest each and every element and limitation of Applicants' claims, combination of Bryan and Capra does not establish a prima facie case of obviousness, and the rejections should be withdrawn.

Relations Among Claims

Independent claim 1 claims method aspects of differential dynamic content delivery according to embodiments of the present invention. Independent claims 14 and 27 respectively claim system and computer program product aspects of differential dynamic content delivery according to embodiments of the present invention. Claim 1 is allowable for the reasons set forth above. Claims 14 and 27 are allowable because claim 1 is allowable. The rejections of claims 14 and 27 therefore should be withdrawn, and claims 14 and 27 should be allowed.

Claims 2-13, 15-26, and 28-39 depend respectively from independent claims 1, 14, and 27. Each dependent claim includes all of the limitations of the independent claim from which it depends. Because the combination of Bryan and Capra does not disclose or suggest each and every element of the independent claims, so also the combination of Bryan and Capra cannot possibly disclose or suggest each and every element of any dependent claim. The rejections of claims 2-13, 15-26, and 28-39 therefore should be withdrawn, and these claims also should be allowed.

In addition to the elements and limitations of the independent claims, the dependent claims 2-13, 15-26, and 28-39, also include such elements and limitations as follows: 'the prerecorded presentation control instruction has an associated time stamp,' 'recording a time stamp in association with the presentation control instruction,' 'receiving from a user participating in the presentation a key phrase and optional parameters for invoking a presentation action,' 'parsing the key phrase and parameters against a voice response grammar into a presentation control instruction,' 'selecting a classified structural element includes selecting a classified structural element in

dependence upon the presentation action identifier and the parameters,' 'selecting a classified structural element having an associated classification identifier that corresponds to the user classification,' 'inserting the selected structural element in a data structure appropriate to the data communications protocol,' 'identifying a presentation document for a presentation, the presentation document including a presentation grammar and a structured document having structural elements classified with classification identifiers,' 'filtering the structured document in dependence upon the user classifications and the classification identifiers,' 'extracting, from the structured document, structural elements having classification identifiers corresponding to the user classifications,' 'writing the extracted structural elements into a session structured document in the session document,' 'filtering the presentation grammar, in dependence upon the extracted structural elements, into a session grammar in the session document,' 'creating, in dependence upon an original document, a structured document comprising one or more structural elements,' 'classifying a structural element of the structured document according to a presentation attribute,' and 'creating a presentation grammar for the structured document, wherein the presentation grammar for the structured document includes grammar elements each of which includes an identifier for at least one structural element of the structured document.' In addition to not disclosing the elements of the independent claims, the proposed combination of Bryan and Capra also does not disclose these additional elements. The rejections of claims 2-13, 15-26, and 28-39, therefore, should be withdrawn, and these claims also should be allowed.

No Suggestion or Motivation to Combine Bryan and Capra

To establish a *prima facie* case of obviousness, there must be a suggestion or motivation to combine Bryan and Capra. *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). The suggestion or motivation to combine Bryan and Capra must come from the teaching of either Bryan or Capra themselves, and the Examiner must explicitly point to the teaching within Bryan or Capra suggesting the proposed combination. Absent such a showing, the Examiner has impermissibly used "hindsight" occasioned by

Applicants' own teaching to reject the claims. *In re Surko*, 11 F.3d 887, 42 U.S.P.Q.2d 1476 (Fed. Cir. 1997); *In re Vaeck*, 947 F.2d 488m 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re Gorman*, 933 F.2d 982, 986, 18 U.S.P.Q.2d 1885, 1888 (Fed. Cir. 1991); *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990); *In re Laskowski*, 871 F.,2d 115, 117, 10 U.S.P.Q.2d 1397, 1398 (Fed. Cir. 1989).

The Office Action at page 5 states its rationale for motivation to combine as:

Both Bryan and Capra are analogous art, since both are directed toward searching and presenting information from the web via a voice interface (Capra, p. 1, Col. 2, par. 3; Bryan, Abstract). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Capra to Bryan, since Capra teaches creating a structured document containing context grammar to help provide access to the shared context for other applications (Capra, p. 6, Sect. 5.2.3) thereby increasing the portability and accessibility of the shared context (Capra, p. 1, Col. 2, par. 1) and Bryan teaches dynamic voice content delivery and would therefore have the benefit of the portable shared context and user query method taught by Capra.

That is, the Office Action takes the position that Bryan at the Abstract, Capra at page 1, column 2, paragraphs 1 and 3, and Capra at section 5.2.3, suggest or motivate the combination of Bryan and Capra. Applicants respectfully note in response that what Bryan at the Abstract in fact discloses is:

A method and system for creating, using, and updating individual user voice portals in a multi-user environment is disclosed. Each user selects data sources, keywords and time intervals for searching the data sources, and grammar for accessing search results. Based on this information, an individual voice portal is created for the user. The requested information is extracted from the specified data sources and cached or stored in a database to increase extraction speed. The user accesses the individual voice portal using a unique identifier assigned to the user and the selected grammar. Because each user has a unique voice portal, the search space for software that interprets the grammar is decreased. As a result, the likelihood of misinterpretation and the time for extracting the requested information are decreased.

That is, Bryan at the Abstract merely describes in generally terms a system for creating, using, and updating individual user voice portals in a multi-user environment. Capra generally discloses allowing a user to browse web pages on their personal computer and then make queries about information viewed on those web pages using a voice user interface. Bryan at the Abstract does not mention anything about querying information previously viewed on web pages, and does not suggest or motivate the proposed combination of Bryan's creating, using, and updating individual user voice portals in a multi-user environment with Capra's allowing a user to browse web pages on their personal computer and then make queries about information viewed on those web pages using a voice user interface. Because neither Bryan nor Capra suggests or motivates the combination of Bryan and Capra, combination of Bryan and Capra does not establish a prima facie case of obviousness, and the rejections should be withdrawn.

Turning now to Capra at page 1, column 2, paragraphs 1 and 3, Capra at section 5.2.3, Applicants respectfully note in response that what Capra at page 1, column 2, paragraphs 1 and 3, in fact discloses is:

We are especially interested in the portability and accessibility of shared context. Shared context needs to be accessible from different environments that have different input/output modalities: personal computers with a keyboard, mouse and large screen; PDAs with small screens and an input stylus; cellular telephones with a small screen and buttons; and voice interfaces for access from any telephone.

...

Using this architecture, we have implemented a system called WebContext. WebContext allows a user to browse web pages on their personal computer and then make queries about information viewed on those web pages using a voice user interface.

That is, Capra at page 1, column 2, paragraphs 1 and 3, discloses is accessing shared contexts from different environments that have different input/output modalities by allowing a user to browse web pages on their personal computer and then make queries

about information viewed on those web pages using a voice user interface. Bryan, however, is directed generally toward generating and providing access to user-defined voice portals. Capra at page 1, column 2, paragraphs 1 and 3, does not mention anything about user-defined voice portals, and does not suggest or motivate the proposed combination of Capra's allowing a user to browse web pages on their personal computer and then make queries about information viewed on those web pages using a voice user interface with Bryan's generating and providing access to user-defined voice portals. Because neither Capra nor Bryan suggests or motivates the combination of Bryan and Capra, combination of Bryan and Capra does not establish a prima facie case of obviousness, and the rejections should be withdrawn.

Turning now to section 5.2.3 of Capra, Applicants respectfully note in response that what Capra at section 5.2.3 in fact discloses is creating a grammar for use by voice applications from the information stored in document models. As mentioned above, however, Bryan is directed generally toward generating and providing access to user-defined voice portals. Capra at section 5.2.3 does not mention anything about user-defined voice portals, and does not suggest or motivate the proposed combination of Bryan's generating and providing access to user-defined voice portals with Capra's allowing a user to browse web pages on their personal computer and then make queries about information viewed on those web pages using a voice user interface. Because neither Bryan nor Capra suggests or motivates the combination of Bryan and Capra, combination of Bryan and Capra does not establish a prima facie case of obviousness, and the rejections should be withdrawn.

CONCLUSION

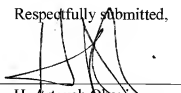
The Office Action objects to claims 28-39 for typographical errors related to the dependency relationships of among the claims. In response, Applicants have amended the claims to correct the dependency relationships.

Claims 1-26 stand rejected under 35 U.S.C § 101 on grounds that the claimed invention is directed to non-statutory subject matter. For the reasons discussed above, the Office Action has not established a prima facie case for rejecting claims 1-26 under 35 U.S.C § 101. Furthermore, Applicants' demonstrated that the claims are limited to a practical application within the technological arts. Claims 1-26, therefore, are patentable and should be allowed. Applicants respectfully traverse each rejection individually and request reconsideration of claims 1-26.

Claims 1-39 stand rejected for obviousness under 35 U.S.C § 103(a) as being unpatentable over Bryan in view of Capra. For the reasons discussed above, the proposed combination of Bryan and Capra does not establish a prima facie case of obviousness against the Applicants' claims. Claims 1-39, therefore, are patentable and should be allowed. Applicants respectfully traverse each rejection individually and request reconsideration of claims 1-39.

The Commissioner is hereby authorized to charge or credit Deposit Account No. 09-0447 for any fees required or overpaid.

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Respectfully Submitted,

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